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REMARKS

The Examiner has rejected Claim 20 under 35 U.S.C. 112, second paragraph, as being indefinite. Specifically, the Examiner has argued that the term "may" fails to point out what is included or excluded by the claim language. Applicant has clarified such claim language to overcome such rejection.

The Examiner has rejected Claims 1-4, 9-10 and 13-24 under 35 U.S.C. 103(a) as being unpatentable over Valco et al. (U.S. Patent No. 6,826,264) in view of Ito et al. (U.S. Patent Application No. 09/839,309) in further view of Victor et al. (U.S. Patent No. 5,363,482) and in even further view of Hopper et al. (U.S. Patent No. 5,367,609). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove to each of the independent claims.

With respect to each of the independent claims, the Examiner has relied on Figure 2 in Valco to make a prior art showing of applicant's claimed "automatically tracking a plurality of states during the execution of the script utilizing the voice browser" (see the same or similar, but not necessarily identical language in each of the independent claims). Applicant notes, however, that such Figure only shows returning a user to a base state which is the message review area. Thus, tracking a plurality of states, in the manner claimed by applicant, is not only undisclosed in Valco, but would be useless in Valco since a user is always only capable of going back to the message review area.

In addition, the Examiner has relied on Col. 9, line 6 in Victor to make a prior art showing of applicant's claimed "determining whether code exists indicating a state other than the previous state to which the script should be transitioned in response to the request" (see the same or similar, but not necessarily identical language in each of the independent claims). Applicant respectfully asserts that Victor's button link commands, such as "Go To Slide n", merely relate to a transition to a slide. Thus, in Victor, a previous state that has been tracked is not transitioned to, in the manner claimed by applicant, but instead a new state is transitioned to where such new state is a specific

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slide. Even if the slide identified in Victor is a slide that was previously navigated to, Victor simply fails to teach that the transitioning to such slide is done utilizing <u>tracked</u> states, in the context claimed by applicant. Further, the claimed "determining whether code exists indicating a state <u>other than the previous state</u> to which the script should be transitioned in response to the request" (emphasis added) is simply not met.

Still with respect to each of the independent claims, the Examiner has relied on the following excerpt from Hopper to make a prior art showing of applicant's claimed technique "wherein the script includes customizable forms and fields."

> "...the script, being customizable for each transaction and subscriber..." (Col. 7, lines 7-9)

Applicant respectfully asserts that, when read in context, such teaching does not meet applicant's specific claim language. In particular, Hopper discloses a "script [that] contains the list of actions to be performed" (see Col. 7, line 5). Thus, in Hopper only the <u>list of actions</u> may be customized. Applicant, on the other hand, claims a script with "customizable <u>forms</u> and <u>fields</u>" (emphasis added), and not merely a customizable predetermined list of actions, as in Hopper.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail

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to teach or suggest <u>all</u> of the claim limitations, as noted above. Nevertheless, despite such paramount deficiencies and in the spirit of expediting the prosecution of the present application, applicant has substantially incorporated the subject matter of Claims 20, 22 and 24 into each of the independent claims.

With respect to the subject matter of Claim 20, as presently incorporated into each of the independent claims, the Examiner has relied on Col. 3, lines 16-17 in Valco to make a prior art showing of applicant's claimed technique "wherein the transitioning to the previous state is capable of being disabled according to at least one of an entire application, a document, a form and a field."

Applicant respectfully asserts that such excerpt merely teaches that "a third predetermined key (e.g. the star key) can cancel an action and immediately return the user to message view." Clearly, a key that a user can press to cancel an action, as in Valco, does not meet applicant's claimed <u>disabling</u> "the transitioning to the previous state." In fact, in Valco, only when a user is setting voice mail preferences can an action be cancelled, and then the user is subsequently returned to message review window. Thus, this *teaches away* from applicant's claim language since applicant claims <u>disabling</u> the transitioning to a previous state whereas Valco expressly discloses <u>returning</u> the user to a message review window.

With respect to the subject matter of Claim 22, as presently incorporated into each of the independent claims, the Examiner has seemed to rely on Col. 3, lines 16-17, Col. 3, line 52, Col. 4, line 47 and Col. 4, lines 47-53 in Valco to make a prior art showing of applicant's claimed technique "wherein transitioning to the previous state retracts an input the user originally entered at the previous state."

Applicant respectfully asserts that none of the excerpts relied on by the Examiner even suggest "transitioning to the previous state [which] retracts an input the user originally entered at the previous state." In fact, Valco only teaches that a user can "cancel an action and immediately return the user to message review." Thus, in Valco

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the user is <u>not</u> returned to a previous state where input was originally entered since the user is only sent back to a message review, and therefore there is no input that can be retracted, in the manner claimed by applicant.

With respect to the subject matter of Claim 22, as presently incorporated into each of the independent claims, the Examiner failed to even consider applicant's claimed technique "wherein a number of previous states a user is capable of transitioning to is customizable." Thus, applicant respectfully requests an allowance or a specific prior art showing of such claim language.

Again, applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest <u>all</u> of the claim limitations, as noted above. A notice of allowance or a proper prior art showing of <u>all</u> of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. BVOCP025).

Respectfully submitted,
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